

Docket No.: 50023-146



#7/LTR
SEP 12/6/02
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Akio KOJIMA, et al.

Serial No.: 09/914,216

Group Art Unit: 2852

Filed: August 23, 2001

Examiner: Grainger, Quana

For: DATA MONITORING METHOD, DATA MONITORING DEVICE, COPYING DEVICE
AND STORAGE MEDIUM

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REQUEST FOR REISSUE OF OFFICE ACTION AND NEW PERIOD FOR REPLY

Commissioner for Patents
Washington, DC 20231

Sir:

In reviewing the Office Action dated August 1, 2002, several defects were noted, for which it is requested that the period for reply be re-started and a new Office Action be issued.

37 C.F.R. § 1.104(a) requires that the "examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention" (emphasis added). 37 C.F.R. § 1.104(a) further requires that the "examination shall be complete with respect to both compliance with the applicable statutes and rules and to the patentability of the invention as claimed". 37 C.F.R. § 1.104(c)(2) requires that "[i]n rejecting claims . . . the examiner must cite the best references at his or her command".

The Examiner set forth five rejections under 35 U.S.C. § 103(a), as follows:

"Claims 1-3, 5, 8, 11-13, 17, 19 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraishi in view of Funada et al.".

"Claims 4, 14-16 and 34-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraishi in view of Funada et al. and further in view of Takagi."

"Claims 7, 9-10, 18 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraishi in view of Funada et al. and in view of Ishii."

"Claims 21-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraishi in view of Funada et al. and further in view of Omura".

"Claims 30-33 and 36-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiraishi in view of Funada et al., and further in view of Ugai".

Funada et al. is not presently of record, as it has not been cited by the Examiner in form PTO-892 and has not been considered by the Examiner, as would be indicated in an appropriately initialed form PTO-1449.

Takagi is not presently of record, as it has not been cited by the Examiner in form PTO-892 and has not been considered by the Examiner, as would be indicated in an appropriately initialed form PTO-1449.

Ishii is not presently of record, as it has not been cited by the Examiner in form PTO-892 and has not been considered by the Examiner, as would be indicated in an appropriately initialed form PTO-1449.

Omura is not presently of record, as it has not been cited by the Examiner in form PTO-892 and has not been considered by the Examiner, as would be indicated in an appropriately initialed form PTO-1449.

Ugai is not presently of record, as it has not been cited by the Examiner in form PTO-892 and has not been considered by the Examiner, as would be indicated in an appropriately initialed form PTO-1449.

There is, therefore, absolutely no indication that the Examiner made a "thorough study" of these references, as required. Consequently, since the aforementioned references were not considered, the Examiner could not have conducted an examination complete with respect to "both compliance with the applicable statutes and rules and to the patentability of the invention as claimed".

Moreover, typical indicia of consideration of the aforementioned references were absent from the Office Action. Instead of the required particularized findings (37 C.F.R. § 1.104(c)(2)), the Examiner merely cited the aforementioned references and plugged in the claim language. For example, with respect to claim 1, the Examiner states: "Hiraishi teaches a data monitoring method comprising: monitoring each copy element of monitoring object data consisting of at least one kind of copy element in accordance with at least one kind of copy inhibition information and stored in inhibition information storage and inhibiting input or output of the monitoring object data if the monitoring determines that said each copy element agrees with a kind of said copy inhibition information". This generalized allegation is legally insufficient under 37 C.F.R. § 1.104.

Second, in citing foreign published applications or patents, 37 C.F.R. § 1.104(d)(1) requires that "their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant . . . to identify the published applications or patents cited" (emphasis added). 37 C.F.R. § 1.104(d)(1) also states that, "in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified" (emphasis added).

Contrary to this requirement, the Examiner has not identified, for the aforementioned patents, "their nationality or country, numbers and dates" in correspondence with the names of the patentees. Therefore, it is difficult, if not impossible, to ascertain at least several of the rejections.

For example, the Examiner cites "Omura". Applicant has submitted, in the Information Disclosure Statement (IDS) filed August 23, 2001, two references JP 3-120561 and JP 3-139974, each to "Omura". It is not clear to which of these references the rejection applies.

Additionally, the Examiner cites "Ugai". This reference was not cited in an IDS by Applicant and was not cited or referred to by reference number by the Examiner. It is impossible to tell to which reference this refers.

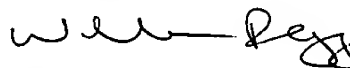
Still further, as noted above, each of the Examiner's rejections is merely a generalized assertion that each of the aforementioned references teaches what is claimed. No attempt was made to identify the particular parts of the reference relied upon or the particular pages and sheets containing such parts, as required by 37 C.F.R. § 1.104.

This request is being made within 1 month of the mailing date of the Office Action.*
Therefore, in accord with MPEP § 710.06, it is submitted that the Office Action is wholly defective and the issuance of a new Office Action curing the aforementioned defects and re-starting the period for reply is requested. No fee is required.

Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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* SEPT. 1 FALLING ON A HOLIDAY WEEKEND